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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* CATHERIN SCHERNER, INKEN GROTH, and  
MAGDALENA VON WEDEL-PARLOW<sup>1</sup>

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Appeal 2019-003304  
Application 14/914,838  
Technology Center 1600

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Before ULRIKE W. JENKS, TAWEN CHANG, and  
MICHAEL A. VALEK, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) involving claims to a cosmetic or dermatological preparation, which have been rejected as obvious. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

STATEMENT OF THE CASE

According to the Specification,

[t]he invention comprises an emulsifier-free, skin conditioning cosmetic or dermatological preparation with

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<sup>1</sup> Appellants identify the Real Party in Interest as Beiersdorf AG. (Appeal Br. 3.)

active ingredients. The preparation is suitable for application to wet skin without being completely rinsed off and thereby allows for rubbing in during showering and the application of skincare and/or skin-protecting active ingredients.

(Spec. 1:5–9.)

Claims 38–57 are on appeal. Claim 38 is illustrative and reproduced below:

38. A cosmetic or dermatological preparation, wherein the preparation is rinseable and emulsifier-free and comprises (i) one or more polyacrylic acid polymers, (ii) one or more C14–22 fatty alcohols, (iii) one or more waxes and/or a hydrocarbon mixture, and (iv) one or more active ingredients, and wherein after rinsing the preparation leaves behind a film on skin to which it has been applied.

(Appeal Br. 18 (Claims App.).)

The Examiner rejects claims 38–47 and 49–57 under 35 U.S.C. § 103 as being unpatentable over Clapp<sup>2</sup> and Patel.<sup>3</sup> (Ans. 3.)

The Examiner rejects claim 48 under 35 U.S.C. § 103 as being unpatentable over Clapp, Patel, and Nguyen<sup>4</sup> and/or Robert.<sup>5</sup> (Ans. 6.)

## DISCUSSION

### *Issue*

The Examiner has rejected claims 38–47 and 49–57 as obvious over Clapp and Patel. The Examiner has also rejected claim 48 as obvious over

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<sup>2</sup> Clapp et al., US 2006/0229953 A1, published Oct. 26, 2006.

<sup>3</sup> Patel et al., US 7,977,289 B2, issued July 12, 2011.

<sup>4</sup> Nguyen et al., US 2010/0322876 A1, published Dec. 23, 2010.

<sup>5</sup> Robert et al., US 2007/0025940 A1, published Feb. 1, 2007.

Clapp, Patel, and Nguyen and/or Robert. The same issues are dispositive for both rejections; we therefore discuss them together.

The Examiner finds that Clapp suggests personal care compositions with excellent skin care and moisturization (i.e., “[a] cosmetic or dermatological preparation) comprising all of the claimed components.” (Ans. 3–4.) With respect to the limitation that the preparation be “emulsifier-free,” the Examiner finds that Clapp “equates surfactants to emulsifiers in their compositions” and “state[s] that their compositions can comprise 0% surfactant.” (Ans. 4–5.) The Examiner also finds that Patel teaches “shower gel compositions substantially free of surfactant (emulsifier) for use in the shower . . . comprising several benefit agents that deposit with greater substantivity on the skin.” (*Id.* at 5.) Accordingly, the Examiner concludes that it would have been obvious to a skilled artisan “to formulate the compositions of Clapp . . . such that they are emulsifier-free so [as] to enhance the deposition and benefits associated with the skin benefit agents in aqueous cosmetic or dermatological compositions to be used in the shower.” (*Id.*)

Finally, although the Examiner finds that Clapp does not explicitly teach that its composition leaves behind a film on skin upon rinsing, as required by the claims, the Examiner finds that the composition suggested by the combination of Clapp and Patel would inherently leave behind such a film because it contains all of the elements of the claimed composition. (*Id.* at 5–6.)

Appellants contend that there is no reason to combine the various optional components taught in Clapp to arrive at the claimed composition. (Appeal Br. 7–9, 11–12; Reply Br. 3–5.) Appellants contend that Clapp in

fact “discourages the provision of a preparation according to the instant invention.” (Appeal Br. 10; *see also* Reply Br. at 4–6.) Appellants contend that Clapp does not teach that its composition “leave[s] behind a film on the skin after they have been rinsed off or disclose which components of the host of optionally employed components would have to be selected to achieve this result.” (Appeal Br. 11; Reply Br. 3–4, 6.) Appellants contend that Clapp does not suggest the additional limitations in independent claim 54 and dependent claims 39, 40, 49, and 55. (Appeal Br. 12–15; Reply Br. 7.) With respect to the rejection of claim 48 as obvious over the combination of Clapp, Patel, and Nguyen and/or Roberts, Appellants contend that claim 48 is patentable for at least the same reasons discussed above. (Appeal Br. 16.)

The issues with respect to these rejections are (1) whether a skilled artisan would have had a reason to combine Clapp and Patel to arrive at the claimed composition and (2) whether the combination of Clapp and Patel suggests compositions that meet the additional limitations in claims 39, 40, 49, 54, and 55.

### *Findings of Fact*

1. Clapp teaches that

there remains the need for compositions that deliver immediate improvements in appearance and skin feel that will effectively deposit on all parts of the body. . . . It is further desirable for the compositions to deliver . . . skin conditioning and appearance benefits via an application and removal process, such as in-the-shower or in-the-bath lotion . . . . Unfortunately for these applications, the moisturizers contained in the compositions are often readily rinsed or otherwise removed from the skin; this is particularly true when surfactant is also present. . . .

[C]ompositions containing structured lipids have been taught to provide enhanced deposition of moisturizers to the skin. It has been recognized that there is increased tackiness of the coating experienced by users when compositions contain more structured lipids and/or lipids with a higher modulus. It is now believed that utilizing a combination of high modulus lipids and esters in compositions, that the deposition of moisturizers can be maintained, while the tackiness of the coating can be substantially reduced upon rinsing, wiping or otherwise removing the product from the keratin surface.

(Clapp ¶ 4.)

2. Clapp teaches “[a] rinsable personal care composition compris[ing] (a) 0 to 75 weight percent of a surfactant; (b) 0.01 to 99 weight percent of a skin benefit agent comprising a high modulus lipid and an ester; and (c) 0 to 99 weight percent water.” (*Id.* at Abstract; *see also id.* ¶¶ 2, 5–7, 24.)

3. Clapp teaches that “rinsable composition,” as used in the reference, means “a composition designed to be rinsed off by a liquid such as water. After the composition is rinsed off, benefit agents remain on the skin.” (*Id.* ¶ 18.)

4. Clapp teaches that “personal care composition,” as used in the reference, “unless otherwise specified, refers to the compositions of the present invention, wherein the compositions are intended for topical application to the skin or hair.” (*Id.* ¶ 17.)

5. Clapp teaches that preferable surfactants include, among others, emulsifiers. (*Id.* ¶ 25.)

6. Clapp teaches that

[t]he composition preferably contains no more than about 50 weight percent of a surfactant, more preferably no more

than about 30 weight percent, still more preferably no more than about 15 weight percent, and even more preferably no more than about 5 weight percent of a surfactant. The composition preferably contains at least about 5 weight percent of a surfactant, more preferably at least about 3 weight percent, still more preferably at least about 1 weight percent, and even more preferably at least about 0.1 weight percent of a surfactant.

(*Id.* ¶ 24.)

7. Clapp teaches its compositions optionally comprise an aqueous phase hydrophobic structuring agent, preferably selected from the group consisting of, among others, saturated C<sub>16</sub> to C<sub>30</sub> fatty alcohols. (*Id.* ¶ 50.) Clapp teaches that these structuring agents “can be useful to assist in the formation of the rheological characteristic of the composition[,], which can contribute to the stability of the composition,” and “tend to assist in the formation of the liquid crystalline gel network structures in the present compositions.” (*Id.* ¶ 50.)

8. Clapp teaches that suitable hydrophobic structuring agents are selected from the group consisting of, among others, stearyl alcohol, cetearyl alcohol, and myristyl alcohol. (*Id.* ¶ 51.)

9. Clapp teaches that the skin benefit agent in its composition comprises a high modulus lipid and an ester and further teaches that the high modulus lipid may optionally comprise a structurant for providing desired rheological properties such as modulus. (*Id.* ¶¶ 53, 61.)

10. Clapp teaches that the structurant may be a natural or synthetic crystalline wax, including microcrystalline wax. (*Id.* ¶¶ 64–65.)

11. Clapp teaches that its compositions may further include one or more thickeners/aqueous phase stability agents. (*Id.* ¶ 147.) Clapp teaches that “[i]t can often be useful to blend different Thickeners/Aqueous Phase

Stability Agents together to generate an optimal stability and rheology profile.” (*Id.*) Clapp teaches that examples of thickening agents useful in the composition include “acrylates/C<sub>10-30</sub> alkyl acrylate crosspolymers that are commercially available as CARBOPOL® 1342, CARBOPOL® 1382, CARBOPOL Ultrez 21, PEMULEN TR-1, and PERMULEN TR-2.” (*Id.* ¶¶ 147–148.)

12. Patel teaches “substantially surfactant free gel compositions comprising hydrophobic and hydrophilic benefits agents” that may be used in the shower and that “deposit with greater substantivity from [the] gel compositions relative to surfactant-containing lotion.” (Patel Abstract, 1:8–17, 2:19–22.)

13. Patel teaches that compositions of its invention comprise an aqueous phase that further comprises a stabilizer, wherein the stabilizers can be “organic, inorganic, or polymeric.” (*Id.* at 5:55–56, 6:1–4.)

14. Patel teaches organic dispersion stabilizers defined as “organic molecules that have a molecular weight generally lower than 1000 Daltons and form a network in the aqueous phase that immobilizes the dispersed oil phase,” wherein “[the] network is comprised either of amorphous solids, crystals, or liquid crystalline phase.” (*Id.* at 6:21–26.)

15. Patel teaches that “[a]n especially preferred type[] of polymeric dispersion stabilizer agent include acrylate containing homo and copolymers” such as “crosslinked poly acrylates sold . . . under the CARBOPOL trade name . . . [and] the PEMULEN trade name.” (*Id.* at 6:62–67.)

16. Patel teaches that “[t]he above dispersion stabilizers can be used alone or in mixtures . . . .” (*Id.* at 7:3–5.)

17. The Specification teaches that

[e]mulsifier-free also encompasses a minimum content of additional emulsifiers of less than 1% by weight, based on the total mass of the preparation, which may be present, for example, as a result of contaminations or entrainments. The influence on the product performance in these quantitative ranges is insignificant if appropriate.

(Spec. 13:30–14:2.)

### *Analysis*

Unless otherwise noted, we adopt the Examiner’s findings of fact and reasoning regarding the Examiner’s rejection of claims 38–40, 54 and 55 under 35 U.S.C. § 103 (Final Act. 2–6, 8–11; Ans. 3–6, 8–14; FF1–15) and agree that these claims are obvious over Clapp and Patel. We provide the following comments for emphasis. Only those arguments timely made by Appellants in the briefs have been considered; arguments not so presented in the briefs are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2015); *see also Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative) (“Any bases for asserting error, whether factual or legal, that are not raised in the principal brief are waived.”).

### Claim 38

Clapp teaches a rinseable personal care composition comprising a skin benefit agent (i.e., “a cosmetic or dermatological preparation . . . compris[ing] . . . one or more active ingredients” as recited in claim 38). (FF2–FF4.) Clapp teaches that preferable surfactants include emulsifiers but also teach that its composition can comprise 0% surfactant. (FF2, FF5.) Clapp teaches that its compositions may comprise polyacrylic acid polymers

such as CARBOPOL® 1342, CARBOPOL® 1382, PEMULEN TR-1, and PERMULEN TR-2 as thickeners and/or aqueous phase stability agents.

(FF11.) Clapp teaches that its composition may comprise C<sub>16</sub> to C<sub>30</sub> fatty alcohols, including stearyl alcohol, cetearyl alcohol, and myristyl alcohol, as structuring agents. (FF7, FF8.) Clapp teaches that the skin benefit agent in its composition may comprise a structurant such as wax. (FF9, FF10.)

Clapp teaches that after its composition is rinsed off, the skin benefit agents remain on the skin. (FF3.) Finally, Clapp suggests that benefit agents in rinseable compositions may be particularly readily removed from the skin when surfactants are present, and Patel teaches that surfactant free gel compositions may achieve superior deposition of benefits agents as compared to lotions containing surfactants. (FF12.)

Because Clapp teaches that its composition may include all of the components recited in claim 38 and comprise 0% surfactant (where “surfactant” is understood to include emulsifiers), and because Clapp and Patel both teach that surfactants may interfere with deposition of benefit agents in rinseable compositions, we find that a skilled artisan would have reason to prepare the emulsifier-free composition recited in claim 38, with a reasonable expectation of success. We further find that the Examiner has established a prima facie case that the composition rendered obvious by Clapp and Patel would “leave[] behind a film on skin” after rinsing, as recited in claim 38: Clapp teaches that benefit agents in its composition remain on the skin after the composition is rinsed off; furthermore, the Examiner has shown that the composition suggested by the combination of Clapp and Patel are substantially identical to the claimed composition such that the burden is shifted to Appellants to show that the composition

suggested by the prior art would not inherently leave behind a film on the skin. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) (explaining that “[w]here . . . the claimed and prior art products are identical or substantially identical . . . the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product”) (citation omitted).

Appellants contend that the claimed components are disclosed in Clapp only as optional components, that Clapp teaches “millions of possible compositions with different combinations of components,” and that, as demonstrated by the exemplified compositions of Clapp, “it is possible to combine the individual elements disclosed by [Clapp] in many different ways without arriving at a composition that is . . . similar to a preparation encompassed by the instant claims.” (Appeal Br. 7; *see also id.* at 8.) Citing *In re Baird*, 16 F.3d 380 (Fed. Cir. 1994), Appellants contend that “the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness.” (Appeal Br. 8.)

We are not persuaded. Appellants’ citation to *Baird* is inapposite. The appellants in *Baird* claimed a flash fusible toner comprising a binder resin which is a bisphenol A polyester containing one of three recited dicarboxylic acids. *In re Baird*, 16 F.3d at 381. The Specification teaches that toners containing bisphenol A have optimal characteristics for flash fusing. *Id.* The prior art disclosed a generic compound formula containing a large number of variables and encompassing more than 100 million different species. *Id.* at 382. Although bisphenol A is one species encompassed by the generic formula, the *Baird* court found that there is no disclosure in the

prior art suggesting that a skilled artisan should select the variables in the generic formula that would result in bisphenol A. *Id.*

While we agree with the holding in *Baird* that “[t]he fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious,” *In re Baird*, 16 F.3d at 382; a claimed invention is also not non-obvious merely because the prior art also made obvious products other than what is claimed. In this case, all of the components recited in claim 38 are known excipients for cosmetic and/or dermatological preparations, and the cited prior art provides explicitly reasons why a skilled artisan may optionally include them in such preparations: That is, skin benefit agents may be included as active ingredients; fatty alcohols and wax may be included as structuring agents and/or structurants, and polyacrylic acid polymers may be included as thickeners and/or aqueous phase stability agents. (FF7–FF11, FF15.)

Thus, this case is closer to *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804 (Fed. Cir. 1989). In that case, the prior art patent disclosed a genus of over 1200 effective combinations of compounds, including the claimed combination. *Id.* at 807. Although Merck argued that neither ingredient of the claimed combination is highlighted in the prior art, that Federal Circuit held that “disclos[ing] a multitude of effective combinations does not render any particular formulation less obvious.” *Id.*

Appellants contend that there is no reason to combine the various optional components taught in Clapp to arrive at the claimed composition. (Appeal Br. 8; *see also id.* at 8–9, 11–12; Reply Br. 3–4.)

We are not persuaded. As discussed above, Clapp and/or Patel provides reasons to include each of the recited components of claim 38 in its

cosmetic or dermatological formulation (i.e., as active ingredients, structuring agents/structurants, thickeners, and/or stability agents). The fact that the components are described as optional does not render the combination of components non-obvious. “[A]ll disclosures of the prior art, including unpreferred embodiments, must be considered.” *In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976).

With respect to the “emulsifier-free” limitation, Appellants contend that Clapp does not suggest this limitation because all of the examples in Clapp contain surfactants, Clapp teaches that the compositions preferably contain at least about 0.1% weight percent surfactant, and “no less than about 2 pages of [Clapp] are devoted to the discussion of suitable surfactants.” (Appeal Br. 9–10.)

We are not persuaded. Clapp teaches that its composition can have as little as 0% surfactant (wherein surfactant includes emulsifiers). (FF2.) Patel, as well as Clapp, also suggests similar reasons why a skilled artisan may wish to limit and/or eliminate surfactant from a cosmetic or dermatological composition, namely that benefit agents are more easily removed from the skin when surfactants are present in the composition and/or that compositions without surfactants have better benefit agent deposition. (FF1, FF12.) As discussed above and as pointed out by the Examiner, “[a] reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non[-]preferred embodiments.” (Ans. 11 (citation omitted).) Thus, Appellants’ emphasis on Clapp’s examples and preferred embodiments, to the exclusion of the remainder of Clapp’s teachings and the teaching of other cited prior art, is misguided.

Furthermore, the Specification defines “emulsifier-free” to encompass “a minimum content of additional emulsifiers of less than 1% by weight.”<sup>6</sup> (FF17.) Clapp teaches that its compositions most preferably contains between 0.1–5 weight percent of a surfactant. (FF6.) Thus, even if we only considered the most preferred amount of surfactant/emulsifier disclosed in Clapp, that range overlaps with the claimed range of emulsifiers (i.e., less than 1% by weight of surfactants). Our reviewing court has explained that, in such a situation (i.e., where the ranges of a claimed composition overlap the ranges disclosed in the prior art), a prima facie case of obviously typically exists.<sup>7</sup> *In re Peterson*, 315 F.3d 1325, 1329 (Fed. Cir. 2003).

Appellants contend that, because Clapp teaches that its compositions preferably comprise a gel network that typically comprises an aqueous phase hydrophobic structuring agent and a surfactant, and because Clapp teaches fatty alcohols as hydrophobic structuring agents, Clapp “strongly suggests” that “if a fatty alcohol is present (as hydrophobic structuring agent), a surfactant/emulsifier should be present as well, contrary to what is recited in the instant claims.” (Appeal Br. 10; *see also* Reply Br. 4–5.)

We are not persuaded. As discussed above, the Specification defines “emulsifier-free” to include compositions containing additional emulsifiers

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<sup>6</sup> Additional emulsifiers refer to emulsifiers other than the polyacrylic acid polymers, which may have an emulsifying effect. (Spec. 13:23–14:2.) The Specification explains that, “in accordance with the invention, the polyacrylic acid polymers which may have an emulsifying effect are not taken to be emulsifiers.” (*Id.* at 13:23–25.)

<sup>7</sup> We note that Clapp teaches examples where the composition contains less than 1% by weight of a surfactant. Examples 3 and 4, for instance, contains 0.25 wt % and 0.3 wt % of Tween 80. These examples would thus appear to fall within the definition of “emulsifier-free” for purposes of the claims.

of less than 1% by weight. (FF17.) Given that Clapp teaches a range of most preferred surfactant amount (i.e., between 0.1% to 5% by weight (FF6)) that overlaps the claimed range, Clapp renders the “emulsifier-free” limitation *prima facie* obvious, even assuming that Clapp teaches that surfactants should also be included whenever fatty alcohols are used as structuring agents in its compositions.

Furthermore, Clapp teaches that it is the aqueous phase hydrophobic structuring agent that “can be useful to assist in the formation of the rheological characteristic of the composition[,] which can contribute to the stability of [Clapp’s] invention” and that “tend to assist in the formation of the liquid crystalline gel network structures in [Clapp’s] compositions.” (FF7.) While Clapp also teaches that “[t]he ‘gel network’ of [its] invention *typically* comprises an aqueous phase hydrophobic structuring agent and a surfactant” (Clapp 4:2–4 (emphasis added)), Appellants have not pointed to any teaching in Clapp that suggests that the inclusion of a surfactant is *necessary* for the structuring agent to perform its function. Thus, we do not agree that Clapp teaches away from an emulsifier-free composition that also contains a fatty alcohol. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (explaining that, “in general, a reference will teach away if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant”); *In re Lamberti*, 545 F.2d at 750 (stating that “all disclosures of the prior art, including unpreferred embodiments, must be considered”).

In this regard, we also note that Patel teaches a surfactant-free gel composition comprising a stabilizer, wherein the stabilizer may be organic dispersion stabilizer(s) that form a liquid crystalline network in the aqueous

phase. (FF14.) Patel's teaching further suggests that liquid crystalline gel network structures may be formed without surfactants; thus, a skilled artisan would have reason to include fatty alcohols in a cosmetic or dermatological composition without surfactants/emulsifiers in view of the combined teachings of Clapp and Patel.

In the Reply Brief, Appellants contend that, "while [Patel] discloses emulsifier-free gel compositions, . . . the (gel) compositions of [Clapp] and the gel compositions of [Patel] have hardly anything in common, wherefore [Patel] is unable to 'neutralize' the clear statement in [Clapp] regarding the (typical) use of surfactant in combination with a structurant." (Reply Br. 5–6.)

As discussed above, we do not agree that Clapp teaches away from using fatty alcohols in an emulsifier-free composition, particularly given the definition of emulsifier-free provided in the Specification. Furthermore, Appellants do not provide any evidence (or even argument) for their contention that Clapp's and Patel's compositions "have hardly anything in common." Both references, for instance, teach using stabilizers and/or structuring agents that form or help to form liquid crystalline networks to stabilize their compositions. Thus, we are also unpersuaded by Appellants' contention that Patel is "unable to 'neutralize' the clear statement in [Clapp] regarding the (typical) use of surfactant in combination with a structurant," to the extent any such neutralization is needed.

Finally, Appellants contend that neither Clapp nor Patel teaches or suggests compositions that "leave behind a film on the skin after they have been rinsed off," as recited in claim 38, or "discloses which components of the host of optionally employed components would have to be selected to

achieve this result.” (Appeal Br. 11; Reply Br. 3–4, 6.) Appellants contend that, “even if the compositions of [Clapp] or [Patel] were assumed to leave behind certain substances on the skin after rinsing, this does not mean that these substances are present on the skin in the form of a (or in a) film.” (Appeal Br. 12.)

We are not persuaded. “[T]he mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.” *In re Best*, 562 F.2d 1252, 1254 (CCPA 1977) (quoting *In re Swinehart*, 439 F.2d 210, 212–13 (CCPA 1971)). Furthermore,

[w]here . . . the claimed and prior art products are identical or substantially identical . . . the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Whether the rejection is based on “inherency” under 35 U.S.C. § 102, on “prima facie obviousness” under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products.

*Id.* at 1255 (citations and footnote omitted).

In this case, the combination of Clapp and Patel suggests emulsifier-free compositions that also contains all of the ingredients recited in claim 38. We therefore find that the burden is shifted to Appellants to show that the composition suggested by the prior art would not “leave behind a film on the skin after they have been rinsed off.” Appellants have not met this burden. Indeed, the evidence of record is to the contrary. Patel, for instance, teaches that its in-shower compositions result in superior deposition of benefit agents when compared to in-shower surfactant-containing lotions, and Clapp

explicitly teaches that benefit agents remain on the skin after its composition is rinsed off. (FF3, FF12.)

Accordingly, we affirm the Examiner's rejection of claim 38.

### Claim 39

Claim 39 depends from claim 38 and further recites that “the film [left behind on the skin after rinsing the preparation] is at least 1  $\mu\text{m}$  thick, as measured by IR-ATR.” (Appeal Br. 18 (Claims App).)

Appellants contend that,

[e]ven if one were to assume that some of the compositions encompassed by the disclosure of CLAPP leave behind a film, the Examiner has not explained why this film would necessarily be at least 1  $\mu\text{m}$  thick or why one of ordinary skill in the art would allegedly have found it obvious to combine some of the optional components mentioned in CLAPP to result in a film which is at least 1  $\mu\text{m}$  thick.

(Appeal Br. 12.)

We are not persuaded for the reasons already discussed with respect to claim 38. The Examiner has established a prima facie case that, in view of Clapp and Patel, it would be obvious for a skilled artisan to arrive at an emulsifier-free composition having all of the claimed ingredients. This shifts the burden to Appellants to show that the composition suggested by the combination of Clapp and Patel would not inherently result in a film on the skin that is “at least 1  $\mu\text{m}$  thick, as measured by IR-ATR,” after the composition is rinsed off. *In re Best*, 562 F.2d at 1255. Appellants have not met this burden.

Accordingly, we affirm the Examiner's rejection of claim 39.

Claims 40, 54, and 55

Claim 40 depend from claim 38 and further recites that the “one or more polyacrylic acid polymers” of the preparation comprises “at least two polyacrylic acid polymers which differ in their properties” and the “one or more C14-22 fatty alcohols” comprises “at least two C14-22 fatty alcohols.” (Appeal Br. 18 (Claims App.)) Claim 54 is an independent claim that claims a cosmetic or dermatological preparation comprising, among other things, “at least two polyacrylic acid polymers which differ in their properties” and “at least two C14-22 fatty alcohols.” (*Id.* at 20 (Claims App.)) Claim 55 depends from claim 54, wherein the “at least two polyacrylic acid polymers which differ in their properties” comprises “at least two polyacrylic acid polymers which differ in their properties.” (Appeal Br. 20 (Claims App.))

Appellants contend that, while Clapp discloses that “combinations of thickeners can (optionally) be present in the compositions disclosed therein and that these thickeners include polyacrylic acid polymers, CLAPP clearly fails to teach or suggest that if a combination of thickeners is employed at all, more than one polyacrylic acid polymer should be employed.” (Appeal Br. 13.) Appellants contend that “each of the 22 exemplified compositions of CLAPP contains either one polyacrylic acid polymer or no polyacrylic acid polymer at all,” and that “in the only exemplified compositions of CLAPP which contain more than one thickener,” including a polyacrylic acid polymer, the other thickener used is “a thickener which is structurally completely different from a polyacrylic acid polymer.” (*Id.*)

With respect to claim 55, Appellants further contend that “none of the exemplified compositions of CLAPP which contains any (‘classic’)

thickener at all appear to contain more than two thickeners” and that Clapp thus does not suggest that its composition should comprise combinations of “three or more thickeners of any kind,” much less “three or more thickeners of the same type.” (*Id.* at 14.)

We are not persuaded by Appellants’ arguments. As mentioned several times above, all of a prior art reference’s disclosures, not just the examples or the preferred embodiments, should be considered for purposes of determining obviousness. *In re Lamberti*, 545 F.2d at 750. While Clapp doesn’t exemplify a composition containing at least two or at least three different polyacrylic acid polymers, Clapp teaches that its composition may comprise one or more thickeners/aqueous phase stability agents, that it can often be useful to blend different thickeners/aqueous phase stability agents together to generate optimal stability and rheology profile, and that examples of such thickeners/aqueous phase stability agents include different polyacrylic acid polymers. (FF11.) The use of at least two or at least three polyacrylic acid polymers in the composition thus appears to be no more than “[t]he combination of familiar elements according to known methods,” which is “likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). Appellants have not suggested that the use of two or more polyacrylic acid polymers in the claimed composition yield unexpected results.

Furthermore, as the Examiner points out, the rejection also relies on Patel for the teaching of the limitation relating to the composition comprising at least two or at least three different polyacrylic acid polymers. (Ans. 14.) In particular, Patel teaches that its compositions comprise an aqueous phase that further comprises a stabilizer, wherein the stabilizer can

be polymeric and wherein especially preferred polymeric stabilizers include polyacrylic acid polymers. (FF13, FF15.) Patel further teaches that the dispersion stabilizers taught in its disclosures may be used alone or in mixtures. (FF16.) Thus, the combination of the teachings of Clapp and Patel renders obvious a cosmetic or dermatological composition comprising two or three different polyacrylic acid polymers.

Appellants do not address the teachings of Patel in their arguments. “Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. . . . [The reference] must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole.” *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Accordingly, we affirm the Examiner’s rejection of claims 40, 54, and 55.

#### Claim 49

Claim 49 depends from claim 38 and further recites that the preparation comprises one or more active ingredients selected from warming substances. (Appeal Br. 19 (Claims App).)

The Examiner asserts that

instant claim 49 does not recite any specific warming substance, other than claiming “one or more active substances selected from warming substances”. Further, the claim is not limited to the warming substances of page 5 of the instant specification because the specification does not define “warming substances” in general or in particular to include those listed on page 5. Accordingly, the claimed term can include any active substance,

including iron oxide, calcium carbonate etc., taught by CLAPP[, which] read on the claimed warming substances.

(Ans. 14; *see also id.* at 4.)

Appellants contend that “the Examiner has not provided any explanation why, let alone evidence that the substances mentioned by the Examiner would be considered to qualify as warming substances by one of ordinary skill in the art.” (Appeal Br. 49; Reply Br. 7.)

We find that Appellants have the better argument. The Specification states:

As warming substances, substances that stimulate the circulation, such as capsaicinoids, are known as active ingredients. The mode of action of these products is based firstly on the promotion of circulation in the areas affected and secondly on an influence on the metabolism. Thus, for example, capsaicin stimulates the elimination of substance P, a neuropeptide made of eleven amino acids. This molecule actively interferes in the pain cycle and contributes to reducing the perceived pain.

(Spec. 5:8–14.) The Specification further states that “[t]he circulation-promoting active ingredients used are preferably capsaicinoids, nonivamide, vanilyl butyl ether, nicotinic acid benzyl ester, nicotinic acid benzyl ester, rosemary oil, capsiate (vanilli acid ester), and mustard oils. (*Id.* at 5:16–18.)

While we agree with the Examiner that warming substances are not limited to the list of preferred circulation-promoting active ingredients listed on page 5 of the Specification, the Specification does teach that “warming substances” are “substances that stimulate the circulation.” (*Id.* at 5:8.) The Examiner has not provided evidence, or even asserted, that the “particulate substances such as iron oxide, silica, calcium carbonate, calcium phosphate

etc.” stimulate the circulation.<sup>8</sup> (Ans. 4, 14.) “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Accordingly, we reverse the Examiner’s rejection of claim 49.

#### Claim 48

Claim 48 depends from claim 38 and recites that the preparation further comprises aluminum starch octenyl succinate. (Appeal Br. 19 (Claims App.)). The Examiner rejected claim 48 as obvious over Clapp, Patel, and Nguyen and/or Robert. Appellants argue that claim 48 is patentable for at least the reasons set forth above with respect to claim 38. We are not persuaded for the reasons already discussed.

Accordingly, we affirm the Examiner’s rejection of claim 48.

#### SUMMARY

For the reasons above, we affirm the Examiner’s rejection of claims 38–40, 54, and 55 as obvious over Clapp and Patel. Claims 41–47, 50–53, 56, and 57, which are not separately argued, fall with claims 38 and 54. 37

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<sup>8</sup> We do not make any findings as to whether iron oxide, silica, calcium carbonate, calcium phosphate, or other ingredients disclosed in Clapp or Patel are, in fact, warming substances within the meaning of the claim. We also do not make any findings as to whether a skilled artisan would have found it obvious to incorporate a warming substance into the composition suggested by Clapp and Patel. We merely find that, on the record before us, the Examiner has not established a prima facie case that the combination of Clapp and Patel suggests a preparation comprising warming substances.

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C.F.R. § 41.37(c)(1)(iv). We also affirm the Examiner's rejection of claim 48 as obvious over Clapp, Patel, and Nguyen and/or Robert. We reverse the Examiner's rejection of claim 49 as obvious over Clapp and Patel.

**TIME PERIOD FOR RESPONSE**

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

**AFFIRMED-IN-PART**